

R E M A R K S

Careful review and examination of the subject application are noted and appreciated.

SUPPORT FOR THE CLAIM AMENDMENTS

Support for the claim amendments may be found in the specification, for example, on page 9 lines 11-15, page 7 lines 2-7, page 11 line 11 - page 12 line 12, page 9 line 1-3 and FIGS. 2-4, as originally filed. Thus, no new matter has been added.

CLAIM OBJECTION

The objection to claim 1 for informalities has been obviated by appropriate amendment and should be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

The rejection of claims 1-3 and 5-20 under 35 U.S.C. §103(a) as being anticipated by Eggers '432 in view of Ellis, U.S. Publication No. 2005/0028208, has been obviated in part by appropriate amendment, is respectfully traversed in part, and should be withdrawn.

The rejection of claim 4 under 35 U.S.C. §103(a) as being anticipated by Eggers in view of Ellis and Wonfor '747 is respectfully traversed and should be withdrawn.

Eggers concerns a system for random access to an audio video data library with independent selection and display at each of a plurality of remote locations (Title). Ellis concerns an interactive television program guide with remote access (Title). Wonfor concerns a method for controlling copy protection in digital video networks (Title).

Ellis does not appear to be valid prior art. Ellis is a continuation of a U.S. application filed July 16, 1999. In contrast, the present application was filed July 14, 1999, **before Ellis was filed**. Therefore, Ellis is not prior art based on its filing date. Ellis does reference two earlier provisional applications from 1998. However, the Office Action does not establish that the material of Ellis relied upon for the rejection is properly supported in at least one of the provisional applications in compliance with 35 U.S.C. §112, first paragraph. (See MPEP §2136.03 III) As such, a *prima facie* case has not been established since Ellis has not been shown to be valid prior art. Since a *prima facie* case has not been established, the applicant is under no obligation to submit evidence of nonobviousness (MPEP §2142).

Furthermore, the proposed motivation to modify Eggers with Ellis appears to be improperly based on the claims. The proposed motivation, conserving bandwidth, is too general because it could cover almost any alteration contemplated and does not

address why the specific proposed modification would have been obvious. There is nothing in the references that would suggest replacing the analog video signals in Eggers with the compressed digital video streams of Ellis. (See Examples of Improper Rejection Under 35 USC 103, Example 17, from *FORMULATING AND COMMUNICATING REJECTIONS UNDER 35 U.S.C. 103 FOR APPLICATIONS DIRECTED TO COMPUTER-IMPLEMENTED BUSINESS METHOD INVENTIONS*, Examiner training materials by C. Cleveland, USPTO.) Additionally, the fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness per MPEP §2143.01.

Furthermore, Ellis and Eggers appear to be non-analogous art based on their different U.S. classifications/subclassifications and different International classifications/subclassifications. In contrast, the Office Action provides no evidence that the references are analogous art. As such, *prima facie* obviousness has not been established. As such, *prima facie* has not been established and the rejections of claims 1-20 should be withdrawn.

Claim 1 provides a control server configured to present a particular one of one or more compressed data streams on a particular one of a plurality of busses as determined by a particular one of a plurality of request signals. In contrast, Eggers appears to be silent regarding insertion of video signals onto a particular bus 17 (alleged similar to the claimed one or

more busses) as determined by a particular request signal. In particular, column 3 line 65-column 4 line 2 of Eggers appears to teach the opposite:

All of the video cartridge players 11 and other signal sources 16 which may be included direct their video signals to a video signal combiner 4, which modulates and combines all signals onto unique frequencies on a single or few cables 17 depending both on the total number of video signals and on the type of cable used.

Nowhere in the above text, or in any other section, does Eggers appear to mention that the video signal combiner 4 presents a particular video signal on a particular bus 17 based on some unidentified particular request signal. Ellis does not appear to cure this deficiency of Eggers. Therefore, Eggers and Ellis, alone or in combination, do not appear to teach or suggest a control server configured to present a particular one of one or more compressed data streams on a particular one of a plurality of busses as determined by a particular one of a plurality of request signals as presently claimed. As such, claim 1 is fully patentable over the cited references and the rejection should be withdrawn.

Claim 1 further provides a drive server configured to present one or more compressed data streams. In contrast, Eggers does not mention video data in the form of a compressed data stream. Furthermore, Ellis appears to be silent regarding any originating source of the video data presenting that video data as a compressed data stream. Even if the VCR player 11 of Eggers was replaced by a DVD player of Ellis, one of ordinary skill in the art

would still understand a DVD player to present an uncompressed video signal. Therefore, Eggers and Ellis, alone or in combination, do not appear to teach or suggest a drive server configured to present one or more compressed data streams as presently claimed. Claims 12 and 14 provide similar language as claim 1.

Claim 1 further provides one or more navigation software modules executable on the control server configured to generate one or more control signals that program a respective one of a plurality of decoder devices in response to one or more user options entered at the respective decoder device. Despite the assertion in the Office Action while rejecting former claim 11, paragraphs 0081, 0084 and 0091 of Ellis appear to be silent regarding navigation software modules executable on a control server as presently claimed. The cited text of Ellis reads:

[0081] Secondary storage device 32 can be any suitable type of analog or digital program storage device or player (e.g., a videocassette recorder, a digital video disc (DVD) player, a hard-disk based storage device, etc.). Program recording and other features may be controlled by set top box 28 using control path 34. If secondary storage device 32 is a videocassette recorder, for example, a typical control path 34 involves the use of an infrared transmitter coupled to the infrared receiver in the videocassette recorder that normally accepts commands from a remote control such as remote control 40. Remote control 40 may be used to control set top box 28, secondary storage device 32, and television 36.

[0084] Digital storage device 31 can be contained in set-top box 28 or it can be an external device connected to set-top box 28 via an output port and appropriate interface. If necessary, processing circuitry in set-top box 28 formats the received video, audio and data signals into a digital file

format. Preferably, the file format is an open file format such as the Motion Pictures Expert Group (MPEG) MPEG-2 standard. The resulting data is streamed to digital storage device 31 via an appropriate bus (e.g., a bus using the Institute Electrical and Electronics Engineers (IEEE) 1394 standard), and is stored on digital storage device 31. Digital storage device 31 and secondary storage device 32 may be integrated into a sophisticated set-top box if desired.

[0091] User television equipment 22 may also have secondary storage device 47, digital storage device 49, or any suitable combination thereof for recording programming. Secondary storage device 47 can be any suitable type of analog or digital program storage device (e.g., a videocassette recorder, a digital video disc (DVD), etc.). Program recording and other features may be controlled by control circuitry 42. Digital storage device 49 can be, for example, a writable optical storage device (such as a DVD player capable of handling recordable DVD discs), a magnetic storage device (such as a disk drive or digital tape), or any other digital storage device.

Nowhere in the above text, or in any other section, does Ellis appear to discuss a "control server" type device executing navigation software modules. Eggers does not appear to cure this deficiency of Ellis. Therefore, Ellis and Eggers, alone or in combination, do not appear to teach or suggest one or more navigation software modules executable on the control server configured to generate one or more control signals that program a respective one of a plurality of decoder devices in response to one or more user options entered at the respective decoder device as presently claimed. Claims 13 and 14 provide similar language as claim 1. As such, claims 1, 13 and 14 are fully patentable over the cited references and the rejection should be withdrawn.

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Claim 12 provides one or more decoder control circuits within the control server. In contrast, both Eggers and Ellis appear to be silent regarding any "decoder control" type circuit in the system supervisor computer 1 of Eggers (alleged similar to the claimed control server.) Therefore, Eggers and Ellis, alone or in combination, do not appear to teach or suggest one or more decoder control circuit within the control server as presently claimed. As such, claim 12 is fully patentable over the cited references and the rejection should be withdrawn.

Regarding claim 4, the Office Action does not establish motivation to combine Eggers and Ellis with Wonfor. The proposed motivation, implementing various features, is too general because it could cover almost any alteration contemplated and does not address why the specific proposed modification would have been obvious. There is nothing in the references that would suggest adding the diagnostic mode of Wonfor to the set top boxes of Ellis. (See Examples of Improper Rejection Under 35 USC 103, Example 17, from *FORMULATING AND COMMUNICATING REJECTIONS UNDER 35 U.S.C. 103 FOR APPLICATIONS DIRECTED TO COMPUTER-IMPLEMENTED BUSINESS METHOD INVENTIONS*, Examiner training materials by C. Cleveland, USPTO.) Additionally, the fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness per MPEP §2143.01.

Furthermore, Wonfor appears to be non-analogous art compared with Eggers and Ellis base on their different U.S. classifications/subclassifications and different International classifications/subclassifications. In contrast, the Office Action provides no evidence that the references are analogous art. As such, *prima facie* obviousness has not been established and the rejection of claim 4 should be withdrawn.

Claims 2, 5-9, 13, 15-17, 19 and 20 depend from claims 1, 12 and 14, which are now believed to be allowable. Since the dependent claims contain all of the limitations of the independent claims, the dependent claims are fully patentable over the cited references and the rejections should be withdrawn. New claims 21-25 depend from claims 1 and 12, which are now believed to be allowable. Since the dependent claims contain all of the limitations of the independent claims, the dependent claims are fully patentable over the cited references and should be allowed. The above amendments are being submitted now for the first time because the new Eggers-Ellis ground of rejection has been presented in the current Office Action for the first time (37 CFR 1.116).


Accordingly, the present application is in condition for allowance. Early and favorable action by the Examiner is respectfully solicited.

The Examiner is respectfully invited to call the Applicant's representative at 586-498-0670 should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge Deposit Account No. 12-2252.

Respectfully submitted,

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